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Serial No. 10/037,502
Response to Office Action Mailed January 25, 2007**REMARKS**

In the Office Action, the Examiner rejected claims 1, 3, 9, 11, 17, and 20-24, and objected to claims 2, 4-8, 10, 12-16, and 18. Claims 1-18 and 20-24 are pending in the present application and are believed to be in condition for allowance. In view of the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

As a preliminary matter, Applicants note that the Office Action contained a somewhat confusing error with regard to the references being applied in the rejection. The Examiner initially states that the rejection is based on the combination of U.S. Pat. No. 5,907,689 to Tavallaei et al. (the Tavallaei reference) and U.S. Pat. No. 6,397,287 to Brown et al. (the Brown reference). Specifically, the Examiner stated:

Claims 1, 3, 9, 11, 17, and 20-22, and 24 are rejected under 35 U.S.C 103(a) as being unpatentable over Tavallaei et al. (U.S. Patent No. 5, 907,689 hereinafter "Tavallaei") in view of Brown et al. (U. S. Patent No. 6,397,287 hereinafter "Brown").

Office Action, page 2. However, in the body of the rejection, there is no mention of the Brown reference. Rather, the Examiner refers to U.S. Pat. No. 6,694,389 to Coates et al. (the Coates reference) throughout the Office Action. For example, the Examiner stated:

Coates teaches the above limitation is old and well known (see lines 36-50 of column 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicants invention to modify the system of Tavallaei with the above teachings of Coates.

Office Action, page 3. Applicants believe that the Examiner intended to base the rejection on the combination of the Tavallaei reference and the Coates reference. As such, this

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response is directed to a rejection based on the Tavallaei reference and the Coates reference, and not on the Tavallaei and Brown references.

If, however, the Examiner intended the rejection to be based on the Tavallaei and Brown references, Applicants respectfully request the Examiner re-issue an Office Action clearly setting forth the rejection.

Allowable Subject Matter

In the Office Action, the Examiner stated that claims 2, 4-8, 10, 12-16, and 18 would be "allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Office Action, Page 5. Applicants would like to thank the Examiner for noting the allowability of these claims. However, Applicants believe, based on the arguments and remarks set forth below, all of the pending claims are allowable in their present form.

Claim Rejections under 35 U.S.C. § 103(a)

In the Office Action, Applicants believe the Examiner rejected claims 1, 3, 9, 11, 17, 20-22 and 24 as being unpatentable over the Tavallaei reference in view of the Coates reference; and rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over the Tavallaei reference in view of the Coates reference as applied to claims 1, 9, 17, and 21 above, and further in view of Chin et al. (U.S. Patent No. 5,299,315, hereafter referred to as "the Chin reference"). Applicants respectfully traverse these rejections.

Legal Precedent

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The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Independent Claim 1, 9 and 21

Applicants respectfully assert that neither the Tavallaei reference nor the Coates reference, taken alone or in hypothetical combination, disclose every feature of independent claims 1, 9 and 21. For example, independent claim 1 recites “an embedded bus master being adapted to *take control of the communication bus* ... wherein taking control of the communication bus comprises slowing a rate of snooped data arrival at the FIFO without diverting the snooped data.” (Emphasis added). Independent claim 9 recites an “embedded bus master being adapted to take *control of the communication bus* ... wherein taking control of the communication bus comprises *initiating a read transaction on the communication bus*.” (Emphasis added). Independent claim 21 recites a “bus master *communicatively coupled to the bus*, the bus master configured to throttle the flow

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of snooped data ... wherein throttling the flow of snooped data comprises slowing a rate of snooped data arrival to the queue without diverting the snooped data.” (Emphasis added).

In sharp contrast, neither the Tavallaei reference nor the Coates reference disclose the above-quoted features. In the Office Action, the Examiner conceded that “Tavallaei fails to teach an embedded bus master that is operatively connected to the communication bus, the embedded bus master being adapted to take control of the communication bus.” Office Action, page 3. As such, the Examiner relied upon the Coates reference to cure this deficiency. However, Applicants respectfully assert that the Coates reference does not teach or suggest the above recited features. Rather, the Coates reference describes a system that regulates the fullness of a FIFO buffer by controlling the transfer rates of a *data producer* and a *data receiver*. See Coates, Fig. 5; col. 3, lines 36-50. Specifically, if an upper fullness threshold for the buffer is exceeded, the *data producer* is signaled to decrease its transfer rate and the *data receiver* is signaled to increase its transfer rate. See *id.* Alternatively, if a lower fullness threshold for the buffer is exceeded, the *data producer* is signaled to increase its transfer rate and the *data receiver* is signaled to decrease its transfer rate. See *id.* As such, the Coates reference simply teaches controlling a FIFO by controlling the *data producer and the data receiver*. There is nothing in the Coates reference that teaches a bus master being coupled to a bus, not to mention a bus master taking control of the bus. Therefore, contrary to the Examiner’s assertion, the Coates reference does not teach or suggest the above-recited features of independent claims 1, 9 and 21. Accordingly, Applicants respectfully request withdrawal of the pending Section 103 rejections and allowance of independent claims 1, 9 and 21 as well as the claims that depend therefrom.

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Additionally, with particular regard to claim 9, neither the Tavallaei reference nor the Coates reference, taken alone or in hypothetical combination teaches or suggests taking control of the communication bus by *initiating a read transaction on the communication bus*, as set forth in claim 9. For this additional reason, Applicants respectfully request withdrawal of the rejection under Section 103 and allowance of claim 9 and all claims depending therefrom.

Independent claims 17

Applicants also respectfully assert that neither the Tavallaei reference nor the Coates reference teach or suggest the features of independent claim 17. Independent claim 17 recites "*preventing further transfers on the communication bus ... wherein preventing further transfers of data comprises initiating a read transaction on the communication bus.*" (Emphasis added).

As noted above, the Examiner conceded in the most recent Office Action that the Tavallaei reference did not disclose the above recited features and relied upon the Coates reference to cure this deficiency. Office Action, page 3. However, the Coates reference does not disclose the above-recited claim features. Rather, as explained in more detail above, the Coates reference merely discloses controlling a data producer and a data receiver to increase or decrease their respective transfer rates. See Coates, Fig. 5; col. 3, lines 36-50. The increasing or decreasing of transfer rates, however, does not prevent further transfers on the communication bus, as set forth in claim 17. Furthermore, as stated above with regard to claim 9, there is no teaching or suggestion in either the

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Tavallaei or Coates references of taking control of the communication bus by *initiating a read transaction on the communication bus*. For at least these reasons, Applicants respectfully assert that neither the Tavallaei reference nor the Coates reference, either alone or in hypothetical combination, teach or suggest the above-recited features of independent claim 17. Accordingly, Applicants respectfully request withdrawal of the pending Section 103 rejection and allowance of claim 17, as well as the claims that depend therefrom.

Dependent claim 23

As stated above, the Examiner rejected claim 23 as obvious over the Tavallaei reference in view of the Coates reference and further in view of the Chin reference. Applicants respectfully submit that claim 23 is allowable based on its dependency on claim 21 because the Chin reference does not cure the deficiencies described above with regard to the Tavallaei and Coates references. For at least this reason, claim 23 is believed to be allowable over the cited references taken alone or in conjunction with each other. Thus, Applicants respectfully request withdrawal of the rejection of claim 23.

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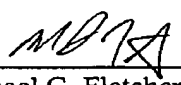
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Conclusion

Applicants respectfully submit that all pending claims are in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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